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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,709	03/18/2004	Dennis O'Neel	P06664US0	7825
34082	7590	05/17/2006	EXAMINER	
ZARLEY LAW FIRM P.L.C.			TAI, CYRIL	
CAPITAL SQUARE				
400 LOCUST, SUITE 200			ART UNIT	
DES MOINES, IA 50309-2350			PAPER NUMBER	
			1723	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/803,709

Applicant(s)

O'NEEL, DENNIS

Examiner

Cyril Tai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office action is in response to Amendment filed on 4/25/2006.

#### ***Claim Analysis***

1. The preamble of claims 1 and 7 disclose an oil filter with intended use in an engine combination. For examination purposes, this subcombination (oil filter alone) has been deemed to be recited.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: the reference numbers to the magnetic sleeve in the specification (12) (p. 5, lines 10 and 14) and in Figure 3 (24) do not match. Please correct the reference number in the specification or drawing. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Brunsting (US 5,932,108).

Regarding claim 1, Brunsting discloses an oil filter (10) (col. 5, lines 52-53) comprising: an elongated cylindrical filter (Fig. 1) having a first open end (28) with a rim (26) in fluid communication with an engine (col. 5, lines 19-22) and a second closed end

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(col. 4, lines 63-64); and a casing (34) of rare earth magnets (34) (col. 5, lines 36-53) surrounding the rim on the first open end of the filter (Figs. 1 and 2).

Regarding claim 2, Brunsting discloses the oil filter of claim 1 wherein the rare earth magnet is a samarium cobalt magnet (col. 5, lines 47-51).

Regarding claim 3, Brunsting discloses the oil filter of claim 1 wherein the rare earth magnet is a neodymium iron boron magnet (col. 5, lines 47-53).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wascher et al (US 5,441,647) in view of Brunsting ('108).

Regarding claim 7 Wascher et al disclose an oil filter (12) (col. 3, lines 50-51) comprising: an elongated cylindrical filter (Figs. 1, 3A) having an open end (14) in fluid communication with an engine (col. 1, lines 8-21) and a second closed end (33) formed

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from a magnet (34). Wascher et al differs from claim 7 in that it fails to teach a rare earth magnet.

Brunsting teaches an oil filter (10) (col. 5, lines 52-53) comprising: an elongated cylindrical filter (Fig. 1) having a first open end (28) with a rim (26) in fluid communication with an engine (col. 5, lines 19-22) and a second closed end (col. 4, lines 63-64); and a rare earth magnet (34) (col. 5, lines 36-53) surrounding the rim on the first open end of the filter (Figs. 1 and 2). The rare earth magnets include neodymium iron boron magnets or samarium cobalt magnets. Wascher et al and Brunsting are analogous art in that both teach oil filters comprising an elongated cylindrical filter having an open end in fluid communication with an engine and a closed end, and a magnet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention in view of the teachings of Brunsting to replace the magnet of the oil filter of Wascher et al with a rare earth magnet (including neodymium iron boron or samarium cobalt) in order to have sufficient magnetic strength, resistance to the longer-term effects of heat and oil-fluid, sufficient physical strength and strong resistance to demagnetization (col. 5, lines 36-53 of Brunsting).

Claim 8 adds the further limitation, the oil filter of claim 7 wherein the rare earth magnet is a samarium cobalt magnet. Brunsting teaches an oil filter as discussed above. Wascher et al and Brunsting are analogous art as discussed above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention in view of the teachings of Brunsting to replace the magnet of the

oil filter of Wascher et al with a samarium cobalt magnet in order to have sufficient magnetic strength, resistance to the longer-term effects of heat and oil-fluid, sufficient physical strength and strong resistance to demagnetization (col. 5, lines 36-53 of Brunsting).

Claim 9 adds the further limitation, the oil filter of claim 7 wherein the rare earth magnet is a neodymium iron boron magnet. Brunsting teaches an oil filter as discussed above. Wascher et al and Brunsting are analogous art as discussed above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention in view of the teachings of Brunsting to replace the magnet of the oil filter of Wascher et al with a neodymium iron boron magnet in order to have sufficient magnetic strength, resistance to the longer-term effects of heat and oil-fluid, sufficient physical strength and strong resistance to demagnetization (col. 5, lines 36-53 of Brunsting).

### ***Response to Arguments***

8. Applicant's arguments filed 4/25/2006 have been fully considered but they are not persuasive.

9. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

10. Regarding arguments concerning claims 1-3 (rejected under 35 U.S.C 102), Brunsting discloses a casing (36) of rare earth magnets (24). Since claim 1 is open-

ended, i.e. "comprising", Brunsting meets the limitation of a rare earth magnet because Brunsting discloses at least a rare earth magnet.

Furthermore, the Office responds that the broadest, reasonable interpretation of "rim" is an outer curved or circular edge or border of something. Therefore, "rim" is not necessarily drawn to the top edge of the filter. A "rim" can be the outer circumference of the filter.

Furthermore, it is not claimed in claim 1 or disclosed in the applicant's specification that a rare earth magnet independently surrounds the filter, as the applicant argues that it requires.

11. Regarding arguments concerning claims 7-9, a second closed end formed from a rare earth magnet would have been obvious from the combination of Wascher et al and Brunsting. The Office responds that the broadest, reasonable interpretation of "an elongated cylindrical filter having ... a second closed end formed from a rare earth magnet" merely states that the filter has a second closed end formed from a rare earth magnet, and does not specify further spatial arrangement to which the second closed end should be located with respect to the filter. Therefore, the scope of this claim encompasses the combination of Wascher et al and Brunsting, meeting all the structural limitations set forth in the claim as above. Applicant argues that the combination of Wascher et al and Brunsting teach sleeves for fitting over the bottom of a filter canister to bring a magnet into close proximity with the bottom of the filter canister. As above, claim 7 does not specify further spatial arrangement to which the second closed end should be located with respect to the filter.

Furthermore, applicant alleges unexpected results from the combination of Wascher et al and Brunsting. Applicant has not provided evidence to show that the combination of Wascher et al and Brunsting would lead to unexpected results. The burden is on the applicant to establish results that are unexpected and significant. See MPEP 716.02(b).

12. Applicant's arguments, see pg. 6-7 of applicant's arguments, filed 4/25/2006, with respect to claims 1-3 (rejected under 35 U.S.C 103) have been fully considered and are persuasive. The rejection of claims 1-3 (rejected under 35 U.S.C 103) has been withdrawn.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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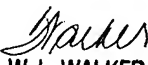
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cyril Tai whose telephone number is (571) 272-1495. The examiner can normally be reached on Monday-Friday from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cyril Tai  
Examiner  
Art Unit 1723

CT  
5/15/2006

  
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